

REMARKS

In the final Office Action mailed March 12, 2009, claims 1-30 and 47 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; claims 1-10, 13-20, 31-33 and 43-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis, et al.; “A Formal Process for evaluating COTS Software Products”, (C) 2001 IEEE, Computer, pp. 58-63 (hereinafter “Lawlis”) in view of Mamoukaris et al; “Evaluation of web-based educational systems”, 2000, vol. 1, Academy of Business Education, pp. 1-6 (hereinafter “Mamoukaris”); claims 11, 12, 21-30 and 34-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and in further view of Cheryl Murphy, An Evaluation Format For “Open” Software Tools, Computers and Human Behavior, vol. 11, no. 3-4 , pages 619-631, 1995, (hereinafter “Murphy”) and Matthew Owen Howard, R. Dale Walker, Patricia Silk Walker, & Richard T. Suchinsky, Alcohol and Drug Education in Schools of Nursing, Journal of Alcohol and Drug Education, vol. 42, issue 3, Spring 1997, at 54, (hereinafter Howard); and claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and in further view of Richard B. Freeman; “Occupational Training In Proprietary Schools and Technical Institutes”; The Review of Economics and Statistics, Vol. 56, No. 3 (Aug. 1974), pp. 310-318 (hereinafter “Freeman”). Applicants respectfully traverse and request reconsideration.

Claims 1-30 and 47 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, it is alleged that claims 1-30 and 47 are method claims that fail to either (i) tie the claimed subject matter to another statutory class or (ii) transform underlying subject matter to a different state or thing, citing various Supreme Court precedents and, presumably, the Court of Appeals for the Federal Circuit’s recent *In re Bilski* decision. In light of this, claims 1, 5 and 21 have been amended above to recite the particular apparatus used

to perform the claimed method, i.e., a computer, thereby alleviating any possibility that the claims are wholly preemptive. Applicants note that these amendments do not add new subject matter to the instant disclosure (see, e.g., ¶¶ 0026 & 0031; FIG. 1). As such, Applicants respectfully submit that claims 1, 5 and 21 as amended above (as well as dependent claims 2-4, 6-20, 22-30 and 47) at least satisfy the “machine” prong of the so-called machine-or-transformation test and therefore encompass patentable subject matter.

Claims 1-10, 13-20, 31-33 and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris. With regard to claim 5, the Office Action notes that Lawlis teaches the claimed limitations with the exceptions of (i) “educational product alignment values, for indicating the alignment of each educational product to said business organization’s goals with respect to employee training”; (ii) “wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area”; and (iii) “wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course”. To supplant these shortcoming, Mamoukaris is cited as teaching these claim limitations. While Applicants agree that Lawlis fails to teach these limitations, Applicants respectfully traverse the assertion that Mamoukaris does teach them.

In particular, with regard to the limitation of “educational product alignment values, for indicating the alignment of each educational product to said business organization’s goals with respect to employee training”, Mamoukaris is simply silent on this point altogether. Indeed, the Office Action, unlike the other two limitations noted above, fails to provide *any* citation to teachings of Mamoukaris regarding this limitation. This is not surprising because, by its very terms, Mamoukaris is directed to the “review of five popular Web-Based Education Tools” (p. 2,

first paragraph) according to various “comparison criteria” concerning features of the education products themselves (p. 3-5, Section III), not a potential user’s goals with respect to training. For this reason, Applicants respectfully submit that the combination of Lawlis in view of Mamoukaris fails to establish *prima facie* obviousness of claim 5 to the extent that it fails teach each limitation recited in claim 5.

Furthermore, Applicants have noted the argument on pages 5-6 of the Detailed Action that the claimed “business goal rule data representing a business organization’s goals with respect to employee training” constitutes “descriptive material [that] will not distinguish the prior art in terms of patentability”, citing M.P.E.P. § 2106 and two precedents cited therein, specifically *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031 (Fed. Cir. 1994). In so doing, it appears that the Office Action is drawing an equivalence between the claimed “business goal rule data representing a business organization’s goals with respect to employee training” and so-called “printed matter”. In response, Applicants first note that the discussion of “printed matter” in M.P.E.P. § 2106 as well as the *Gulack* and *Lowry* decisions address the use of printed matter in apparatus claims, particularly whether limitations encompassing printed matter may be properly considered when assessing patentability of apparatus claims. Both *Gulack* and *Lowry* reject the view that categorization of a limitation as “printed matter” is sufficient to disregard such limitation, but rather that such limitations will not be given “patentable weight . . . absent a new and unobvious functional relationship between the printed matter and the substrate.” *Lowry*, 32 F.3d at 1582, 32 USPQ.2d at 1034. In particular, the court in *Gulack* found that digits printed on a continuous band should be considered for purposes of patentability. *Gulack*, 703 F.2d at 1387, 217 USPQ at 405. More relevant to the instant application, the court in *Lowry* rejected the notion that the

“printed matter” rejections may be applied to claim limitations that include “information stored in a memory”, noting that “printed matter cases have no factual relevance where ‘the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.’” *Lowry*, 32 F.3d at 1583, 32 USPQ.2d at 1034 (quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969)). In the instant application, claim 5 has been amended above to precisely state that the claimed business goal rule data is stored in memory and that the claimed method is implemented by a computer. As such, Applicants respectfully submit that the reliance of the Office Action on “printed matter” grounds is improper and that the presently-claimed “business goal rule data representing a business organization’s goals with respect to employee training” must be considered. Even if one were to somehow construe the business goal rule data as printed matter, the presently claimed business goal rule data clearly presents at least as much “patentable weight” as the printed digits found sufficient in *Gulack* when one considers that the business goal rule data is intimately tied to the processing set forth in instant claim 5.

Thus, to the extent that the “business goal rule data representing a business organization’s goals with respect to employee training” must be considered and is clearly not taught by the combination of Lawlis in view of Mamoukaris, Applicants respectfully request withdrawal of the rejection of claim 5. Furthermore, independent claims 1, 31 and 43 also include this limitation, rendering these claims patentable for at least the same reasons as claim 5 set forth above. Further still, dependent claims 2-4, 6-10, 13-20, 32, 33 and 44-46 incorporate the limitations of respective ones of independent claims 1, 5, 31 and 43, thereby rendering these dependent claims allowable for at least the same reasons.

Claims 11, 12, 21-30 and 34-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and in further view of Murphy and Howard. As an initial matter, Applicants note that the further application of Murphy and Howard to the combination of Lawlis and Mamoukaris fails to over the shortcomings of Lawlis/Mamoukaris noted above, i.e., their failure to teach “business goal rule data representing a business organization’s goals with respect to employee training”. Applicants further note that independent claim 21, 34 and 39 include the “business goal rule data representing a business organization’s goals with respect to employee training” limitation and are therefore in suitable condition for allowance for at least the same reasons presented above with regard to claim 5. Further still, dependent claims 11, 12, 22-30, 34-38 and 40-42 incorporate the limitations of respective ones of independent claims 5, 21, 34 and 39, thereby rendering these dependent claims allowable for at least the same reasons presented above.

Finally, claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and in further view of Freeman. Once again, Applicants note that the further application of Freeman to the combination of Lawlis and Mamoukaris fails to over the shortcomings of Lawlis/Mamoukaris noted above, i.e., their failure to teach “business goal rule data representing a business organization’s goals with respect to employee training”. Thus, to the extent that claim 47 is dependent upon, and therefore incorporates the limitations of claim 5, Applicants respectfully submit that claim 47 is in suitable condition for allowance for at least the same reasons presented above with regard to claim 5.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully requests reconsideration and withdrawal all presently outstanding rejections. Thus, prompt and favorable consideration of this response is respectfully requested. If it is believed that personal communication will expedite prosecution of this application, Applicant's undersigned representative may be contacted at the number below.

Respectfully submitted,

Christopher P. Moreno

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By: _____

Christopher P. Moreno
Registration No. 38,566

Vedder Price P.C.
222 N. LaSalle Street
Chicago, Illinois 60601
Phone: (312) 609-7842
Fax: (312) 609-5005